

REMARKS

In the Office Action dated December 23, 2003, the Examiner rejected claims 1-4, 6-14, 16-23, 25-33, and 35-39 under 35 U.S.C. § 103(a) as being unpatentable over Marks et al. (U.S. Patent No. 5,790,775) in view of Tawil et al. (U.S. Patent No. 6,625,747) and indicated claims 5, 15, 24, and 34 would be allowed if rewritten in independent form.

By this amendment, Applicants have amended claims 5, 15, 24, and 34 in independent form. Accordingly, the objection to these claims is deemed moot and Applicants request that the claims be allowed. Further, Applicants have amended claims 1, 2, 4, 7, 11, 12, 14, 17, 21, 23, 25, 26, 30, 31, 33, 35 and 36 to correct minor typographical errors.

In light of the foregoing amendments and based on the following arguments, Applicants respectfully traverse the Examiner's rejection of claims 1-4, 6-14, 16-23, 25-33, and 35-39 under 35 U.S.C. § 103(a).

I. The Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-4, 6-14, 16-23, 25-33, and 35-39 under 35 U.S.C. § 103(a) as unpatentable because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging

the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

- a. Marks et al. and Tawil et al. do not teach or even suggest all of the recitations of claims 1-4, 6-14, 16-23, 25-33, and 35-39.

The Examiner asserts that Marks et al. "discloses a failover data path in a graphical user interface (col. 7, lines 11-17), comprising displaying source device (host CPU and host interface; fig. 3); displaying target device (target ID; col. 6, lines 48-53)." The Examiner admits that Marks et al. does not teach displaying a first data path between source and target devices. In an attempt to compensate for these shortcomings, the Examiner relies on Tawil et al. See *Office Action*, page 2, ¶ 3. Applicants disagree.

Marks et al. discloses a host storage controller that includes fault tolerant designs and capabilities. In the event of a failure of another controller, the host controller assumes the identity of the failed controller while processing requests directed to the host controller.

Contrary to the Examiner's assertions, Marks et al. does not teach or suggest displaying any graphical representations in a graphical user interface. The citations to the reference presented by the Examiner do not disclose any subject matter that is remotely close to the recitations of Applicants' claimed invention. Indeed, Marks et al.

does not even suggest anywhere in the reference that the system is capable of displaying graphical representations of a data path or connected devices. For example, the Examiner refers to Fig. 3 of Marks et al to support the position that the reference teaches the display of source and target devices. See *Office Action, page 2, lines 13-14*. A proper review of the reference, however, shows that the figure merely depicts a block diagram of a host CPU and a host controller device. The figure and its corresponding description lend no support to the position that Marks et al. teaches the display of any type of graphical representation, much less that of a source device and target device. Accordingly, Applicants traverse the Examiner's assertion that the block diagram depicted in Fig. 3 of Marks et al. teaches graphically displaying at least one source and target device.

Another example of the Examiner's improper interpretation of Marks et al. is shown by the Examiner's reliance on col. 6, lines 49-53 to teach "graphically displaying a target device." A proper review of that portion of the reference shows that the "target ID" refers to an identifier of a controller that the host controller may virtually represent during a failover condition. Nowhere does Marks et al. mention graphically displaying a target device, much less any type of device or component.

Tawil et al. does not compensate for the shortcomings of Marks et al. Tawil et al. discloses a system for handling computer storage system failovers. The system uses multiple storage controllers that share a common node name to allow a host system to virtually see these two controllers as a single unit.

Tawil et al., however, does not teach or suggest graphically displaying a first data path between source and target devices and graphically indicating a failure in the first

data path and displaying a failover path. Indeed, Tawil et al. does not teach or even suggest graphically displaying any type of device or component or status thereof. As with Marks et al., the Examiner misinterprets Tawil et al.

Although the Examiner is correct in stating that Tawil et al. teaches a communication path (i.e., element 28), the Examiner stops short of addressing the actual recitations of Applicants' claimed invention. Tawil et al. does not teach, and the Examiner does not address, graphically displaying a first data path. Further, the Examiner is wrong in asserting Tawil et al. teaches "displaying a failover path" in the Abstract or col. 7, lines 11-18. These portions of the reference merely describe the failover techniques used by Tawil et al. to reroute data communications between storage controllers, and do not teach or suggest graphically displaying any type of device or data path.

Accordingly, contrary to the Examiner's assertions that all of the recitations of claim 1 are taught or suggested by Marks et al. and Tawil et al., these references do not teach or suggest graphically displaying any type of component, data path, or element, much less doing so in a manner consistent with that described in claim 1. Therefore, the rejection of this claim under 35 U.S.C. § 103(a) is unsupported by the prior art, should be withdrawn, and the claim allowed.

Claims 11, 21, and 30 include recitations similar to those of claim 1. As explained, claim 1 is distinguishable from Marks et al. and Tawil et al. Accordingly, the rejection of claims 11, 21, and 30 are also distinguishable from these references for at least the same reasons set forth in connection with claim 1, and Applicants request that

the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 2-4, 6-10, 12-14, 16-20, 22-23, 25-29, 31-33 and 35-39 depend from claims 1, 11, 21, and 30, respectively. As explained, claims 1, 11, 21, and 30 are distinguishable from Marks et al. and Tawil et al. Accordingly, the rejection of claims 2-4, 6-10, 12-14, 16-20, 22-23, 25-29, 31-33, and 35-39 are also distinguishable from these references for at least the same reasons set forth in connection with claims 1, 11, 21, and 30. Further, Marks et al. and Tawil et al., taken alone or in combination, fail to teach or suggest the recitations of these claims. Therefore, Applicants request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

b. There is no motivation to combine Marks et al. and Tawil et al. to suggest Applicants' claimed invention.

There is no motivation to combine Marks et al. with Tawil et al. The Examiner asserts that one skilled in the art would be motivated to "incorporate the communication path between source and target devices as taught by Tawil into the failover operation of Marks' teaching for indicating a failover data path, because it would develop a method to identify paths and controllers to enable more efficient, scalable failover with a SAN." See *Office Action*, page 2, line 19 to page 3, line 1. Applicants disagree with the Examiner.

Determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence." See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless "substantial evidence" found in the record supports the factual

determinations central to the issue of patentability, including motivation, the rejection is improper and should be withdrawn.

In this case, there is no “substantial evidence” in the record to support the attempted combination of Marks et al. and Tawil et al., and the requisite “clear and particular” motivation required to support a *prima facie* case of obviousness is lacking. The Examiner has not established, by substantial evidence, that a skilled artisan having the art before him would have been motivated to combine the teachings of Marks et al. with Tawil et al. in a manner *resulting in Applicants' claimed invention*. Instead, the Examiner asserts that it is obvious to add a communication path to Marks et al. without ever addressing any of the recitations of Applicants' claimed invention. Moreover, the Examiner's reasons for combining Marks et al. and Tawil et al. are erroneous. Marks et al. already uses a data communication path between its controllers. Thus, there is no need to look to Tawil et al. for the use of a communication path. Accordingly, contrary to the Examiner's assertions, one skilled in the art would not be motivated to combine the data communication path taught by Tawil et al. with Marks et al..

Because Marks et al. and Tawil et al. fail to teach or suggest the recitations of claims 1-4, 6-14, 16-23, 25-33, and 35-39, and the Examiner provides no objective reason why, other than to attempt to meet the terms of the claims, a skilled artisan would have been motivated to combine the references, a *prima facie* case of obviousness has not been established. Accordingly, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed.

II. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of claims 1-39.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By 

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